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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,432	01/28/2002	Hirofumi Suda	B422-179	4288
26272	7590	07/28/2005		
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER VIEAUX, GARY	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/058,432	Applicant(s) SUDA, HIROFUMI	
	Examiner Gary C. Vieaux	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Amendment**

The Amendment filed May 10, 2005 has been received and made of record. In response to the first Office Action, the drawings, the title, the specification, and claims 1, 3, 6, and 11 have been amended. Claim 12 has been added.

In response to Applicant's amended title, the Examiner finds the new title to be more indicative of the invention to which the claims are directed. Therefore, the objection to the title is withdrawn.

In response to Applicant's amended drawings, the Examiner finds figure 3 to be properly designated with indicator T2 and amended figure 8 to be properly designated as prior art. Therefore, the objections to the drawing, as they relate to figures 3 and 8, are withdrawn.

In response to Applicant's amended specification, the Examiner finds the amendments directly address the previous inconsistencies between the Drawings and the specification in regards to indicators 107 and 123. Therefore, the objections to the drawings, as they relate to indicators 107 and 123, are withdrawn.

### ***Response to Arguments***

Applicant's arguments filed on May 10, 2005, regarding claims 1 and 11 have been fully considered but they are not persuasive.

Regarding amended independent claims 1 and 11, Applicant contends that references employed do not teach or suggest the manner of read-out control of the

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memory functioning together with moving image data recording start and stop instruction means (Remarks, p. 14 lines 10-12 and 18-21.) The Examiner respectfully disagrees.

McKain is found to provide a teaching of read-out functioning together with image  
5 data recording start and stop instruction means, including providing instruction means for arbitrarily instructing a recording start and a recording stop (camera trigger, p. 23 lines 5-14) in conjunction with the pre-record start instruction data being appended to the succeeding recorded data based on a standard record operation (p. 25 lines 28-32.)

Johnson is found to further teach recording of data before and after a triggering  
10 event to provide additional information temporally related (col. 5 lines 39-50.) It would have been obvious for one of ordinary skill at the time of the invention to include the concept of pre and post event recording as taught by Johnson, within the functionality of a recording apparatus, which already included pre-event recording, as taught by McKain, in order to create a recording apparatus that recorded image data immediately  
15 before a recording start designation, as well as immediately after a recording stop designation. One of ordinary skill in the art at the time of the invention would have been motivated to combine these teachings in order to allow for the acquisition of data related to, and in addition to, the data intentionally acquired during the originally determined recording period (from start designation to stop designation); data which may later be  
20 considered useful.

Based on the foregoing, the Examiner respectfully stands behind the 35 U.S.C. 103(a) rejections to claims 1 and 11.

Regarding claims 2-5, each depend either directly from or indirectly from independent claim 1 and, thus, inherit all the limitations of independent claim 1. Consequently, based on their dependence and the foregoing response to arguments relating to claim 1, the Examiner respectfully stands behind the 35 U.S.C. § 103(a) rejections to claims 2-5.

Applicant's arguments with respect to amended claim 6 have been fully considered and are persuasive. The previous 35 U.S.C. 103(a) of claim 6 has been withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 12** is rejected under 35 U.S.C. 102(b) as being anticipated by McKain et al. (WO 96/26600.)

Regarding claim 12, McKain teaches a recording apparatus comprising recording means for recording moving image data onto a recording medium (fig. 4 indicator 94; p. 9 line 32 – p. 10 line 3) and play list generating means (fig. 3 indicator 36; p. 14 lines 13-16) for generating and updating a play list for controlling reproduction of the moving image data (p. 15 Table I, p. 14 lines 13-16, p. 15 lines 1-4.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable  
10 over McKain et al. (WO 96/26600) in view of Johnson et al. (US 6,163,338.)

Regarding claim 1, McKain is found to teach an apparatus comprising input means (fig. 1 indicator 22), memory means (p.25 lines 30-31), instruction means for arbitrarily instructing a recording start and a recording stop (camera trigger, p. 23 lines 5-14), a recording medium (fig. 4 indicator 94; p. 9 line 32 – p. 10 line 3), and control  
15 means (fig. 3 indicator 36; p. 8 lines 17-18; p. 10 lines 3-4) for controlling said memory and said recording medium interface so as to start and stop recording in response to an instruction, and for appending data prior to a start instruction to the succeeding data recorded based on a standard record operation (p. 25 lines 28-32.) However, McKain is not found to teach recording succeeding moving image data after a recording stop  
20 instruction.

Nevertheless, Johnson is found to further teach recording of data before and after a triggering event to provide additional information temporally related (col. 5 lines 39-50.) It would have been obvious for one of ordinary skill at the time of the invention to include the concept of pre and post event recording as taught by Johnson, within the  
25 functionality of a recording apparatus, which already included pre-event recording, as taught by McKain, in order to create a recording apparatus that recorded image data

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immediately before a recording start designation, as well as immediately after a recording stop designation. One of ordinary skill in the art at the time of the invention would have been motivated to combine these teachings in order to allow for the acquisition of data related to, and in addition to, the data intentionally acquired during the originally determined recording period (from start instruction to stop instruction); data which may later be considered useful. One example of this usefulness would be applied to the case of an earthquake recording opportunity; in which a user did not trigger a recording start until after the initial indications of a recording opportunity began, such as when the user reacts to the start of an earthquake, and is followed by a triggered recording stop, only to find that the recording opportunity was not actually over, such as an aftershock of the earthquake.

Regarding claim 2, McKain and Johnson teach all the limitations of claim 2 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus wherein said recording medium interface records the main moving image signal, the preceding moving image signal, and the succeeding moving image signal as one moving image stream (col. 25 lines 30-32.)

Regarding claim 3, McKain and Johnson teach all the limitations of claim 3 (see the 103(a) rejection to claim 2 supra) including a teaching by McKain regarding an apparatus wherein said control means generates play list data for controlling a reproducing process of the moving image stream so as to reproduce the main moving image signal, and inhibit reproducing of the preceding and succeeding moving image signals in the moving image stream (p. 15, Table I, that illustrates generated play list

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data in which a main image signal can be reproduced, and that moving image signals can be inhibited during a reproducing process) in accordance with the recording stop instruction (p. 17 lines 9-10, indicating list generation after a stop instruction.)

5        Regarding claim 4, McKain and Johnson teach all the limitations of claim 4 (see the 103(a) rejection to claim 3 supra) including a teaching by McKain regarding an apparatus wherein said recording medium interface reproduces the moving image signal recorded in the recording medium (p. 17 lines 7-8; p. 21 lines 26-27), and the play list (p. 24 lines 17-18), and wherein said control means controls a reproducing operation of the moving image data by said recording medium interface according to the  
10       reproduced play list (p. 14 lines 14-16 and lines 20-21; col. 24 lines 16-32.)

Regarding claim 11, although the wording is different, the material is considered substantively equivalent to claim 1, as discussed above, with the exception of the inclusion of audio data obtained by way of a microphone. However, the apparatus as taught by McKain is found to include audio data obtained by a microphone (p. 25 lines  
15       30-31; p. 7 line 13.)

**Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over McKain et al. (WO 96/26600) in view of Johnson et al. (US 6,163,338), in further view of Matsui et al. (US 6,674,955.)

20        Regarding claim 5, McKain and Johnson teach all the limitations of claim 5 (see the 103(a) rejection to claim 4 supra), except for teaching an apparatus further comprising image processing means for executing effect processing on the reproduced



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moving image data, wherein said control means controls said recording medium interface and said image processing means so as to reproduce the preceding moving image signal or the succeeding moving image signal from the recording medium, and execute effect processing for the reproduced preceding or succeeding moving image signal according to effect reproducing designation. Although, it is noted that McKain is found to teach the control means controlling the recording medium interface so as to reproduce the moving image signal from the recording medium for editing purposes (p. 14 lines 14-16; p. 24 lines 22-23.)

Nevertheless, Matsui is found to teach an apparatus including image processing means for executing effect processing on reproduced moving image data (fig. 3 indicator 3; col. 12 lines 9-12), and control means (fig. 4 indicator 3A; col. 13 lines 8-16, indicating control via CPU), wherein said control means controls a recording medium interface and said image processing means (col. 12 lines 18-26), so as to reproduce moving image signals that precede and succeed the designated moving image signal from the recording medium (col. 12 lines 23-26; col. 43 lines 44-52), and execute effect processing for the reproduced moving image signals according to effect reproducing designation (figs. 31B and 37B.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include the image processing means and effects as taught by Matsui, within the apparatus as taught by McKain and Johnson, in order to create an apparatus which not only reproduces successive moving image signals, but also includes transitional effects as a segue from one moving image signal to the next. It would further have been obvious to employ additional time, both preceding and

succeeding the designated start and stop of the moving image signal, as provided above, in order to achieve the transitional effect without impinging on any of the operator designated range of the moving image signal; the transition coinciding with an already present predetermined time before a designated start of a moving image signal and concluding with an already present predetermined time after a designated stop of a moving image signal.

***Allowable Subject Matter***

**Claims 6-10** are allowed.

10        Regarding amended independent claim 6, the prior art is not found to teach or fairly suggest, in combination with the existing elements of the present claim as currently amended, play list data being arranged to control a reproducing process of one moving image stream so as to inhibit reproducing of moving image signals of a first predetermined period from a head of the moving image stream to the recording start instruction and a second predetermined period from the recording stop instruction to an end of the moving image stream, and reproduce a moving image signal of a period other than the first and second predetermined periods in the moving image stream, said recording means recording the play list generated by said generating means on the recording medium.

20        Regarding claims 7-10, the prior art is not found to teach or fairly suggest, limitations of claim 6 from which dependence is derived (see claim 6 supra.)

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE  
5 MONTHS from the mailing date of this action. In the event a first reply is filed within  
TWO MONTHS of the mailing date of this final action and the advisory action is not  
mailed until after the end of the THREE-MONTH shortened statutory period, then the  
shortened statutory period will expire on the date the advisory action is mailed, and any  
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
10 the advisory action. In no event, however, will the statutory period for reply expire later  
than SIX MONTHS from the mailing date of this final action.

***Contact***

Any inquiry concerning this communication or earlier communications from the  
15 examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-  
7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor Thai Q. Tran, can be reached on 571-272-7382. The fax phone number for  
the organization where this application or proceeding is assigned will be 703-872-9306  
20 until September 15, 2005, and beginning July 15, 2005 will become 571-273-8300.

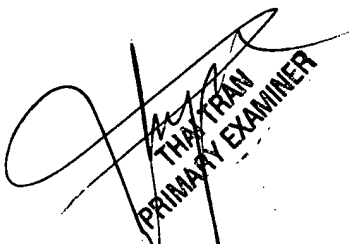
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C. Vieaux  
Examiner  
Art Unit 2612

10 Gcv2

  
THA TRAN  
PRIMARY EXAMINER